



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*toh*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/475,158	12/30/99	GARDELLA	T 0609.4780001
------------	----------	----------	----------------

HM22/0928  
STERNE KESSLER GOLDSTEIN & FOX P L L C  
ATTORNEYS AT LAW  
1100 NEW YORK AVENUE N W  
SUITE 600  
WASHINGTON DC 20005-3934

EXAMINER

LAZAR WESLEY, E

ART UNIT

PAPER NUMBER

1646

10

DATE MAILED:

09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**Office Action Summary**

Applicati n No.

09/475,158

Applicant(s)

GARDELLA ET AL.

Examiner

Janet L Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 5, 13, and 37, drawn to the polypeptide of SEQ ID NO: 1, classified in class 530, subclass 350.
- II. Claim 1-4, 5, 13, and 37, drawn to the polypeptide of SEQ ID NO: 4, classified in class 530, subclass 350.
- III. Claims 1-4, 5, 13, and 37, drawn to the polypeptide of SEQ ID NO: 67, classified in class 530, subclass 350.
- IV. Claims 1-3, 5, 6, 13, and 37, drawn to the polypeptide of SEQ ID NO: 2, classified in class 530, subclass 350.
- V. Claims 1-3, 5, 6, 13, and 37, drawn to the polypeptide of SEQ ID NO: 63, classified in class 530, subclass 350.
- VI. Claims 1-3, 5, 6, 13, and 37, drawn to the polypeptide of SEQ ID NO: 8, classified in class 530, subclass 350.
- VII. Claims 1-3, 5, 6, 13, and 37, drawn to the polypeptide of SEQ ID NO: 12, classified in class 530, subclass 350.
- VIII. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 3, classified in class 530, subclass 350.
- IX. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 5, classified in class 530, subclass 350.

- X. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 6, classified in class 530, subclass 350.
- XI. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 64, classified in class 530, subclass 350.
- XII. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 65, classified in class 530, subclass 350.
- XIII. Claims 1-3, 5, 7, 13, and 37, drawn to the polypeptide of SEQ ID NO: 66, classified in class 530, subclass 350.
- XIV. Claims 1-3, 5, 8, 9, 12, 13, and 37, drawn to the polypeptide of SEQ ID NO: 9, classified in class 530, subclass 350.
- XV. Claims 1-3, 5, 8, 9, 12, 13, and 37, drawn to the polypeptide of SEQ ID NO: 11, classified in class 530, subclass 350.
- XVI. Claims 1-3, 5, 8, 9, 12, 13, and 37, drawn to the polypeptide of SEQ ID NO: 13, classified in class 530, subclass 350.
- XVII. Claims 1-3, 5, 10, 13, and 37, drawn to the polypeptide of SEQ ID NOs: 42 and 43, classified in class 530, subclass 350.
- XVIII. Claims 1-3, 5, 11, 13, and 37, drawn to the polypeptide of SEQ ID NOs: 44 and 45, classified in class 530, subclass 350.
- XIX. Claims 1-3, 5, 13, 14, and 37, drawn to the polypeptide encoded by SEQ ID NO: 14, classified in class 530, subclass 350.
- XX. Claims 1-3, 5, 13, 14, and 37, drawn to the polypeptide encoded by SEQ ID NO: 15, classified in class 530, subclass 350.

- XXI. Claims 1-3, 5, 13, 14, and 37, drawn to the polypeptide encoded by SEQ ID NO: 16, classified in class 530, subclass 350.
- XXII. Claims 15, 26, and 27 drawn to the polynucleotide encoding the polypeptide of Group I and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXIII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group II and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXIV. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group III and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXV. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group IV and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXVI. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group V and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXVII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group VI and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXVIII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group VII and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXIX. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group VIII, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXX. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group IX and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXXI. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group X and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXXII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XI and means of expression, classified in class class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXXIII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XII and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

XXXIV. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XIII and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.

- XXXV. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XIV and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXXVI. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XV and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXXVII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XVI and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXXVIII. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XVII and means of expression, classified in class class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XXXIX. Claims 15, 26, and 27, drawn to the polynucleotide encoding the polypeptide of Group XVIII and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XL. Claims 16-18, drawn to a polypeptide of the formula R-S-L-R or S-L-R, classified in class 530, subclass 350.
- XLI. Claim 19, drawn to a polynucleotide encoding a polypeptide of formula R-S-L-R or S-L-R, classified in class 435, subclass 69.1.
- XLII. Claims 20 and 21, drawn to a polypeptide of the formula S-R, classified in class 530, subclass 350.

- XLIII. Claim 22, drawn to the polypeptide of SEQ ID NO: 37, classified in class 530, subclass 350.
- XLIV. Claim 22, drawn to the polypeptide of SEQ ID NO: 39, classified in class 530, subclass 350.
- XLV. Claim 22, drawn to the polypeptide of SEQ ID NO: 41, classified in class 530, subclass 350.
- XLVI. Claims 23-25, 28, and 29, drawn to the polynucleotide of SEQ ID NO: 36 and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XLVII. Claims 23-25, 28, and 29, drawn to the polynucleotide of SEQ ID NO: 38 and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XLVIII. Claims 23-25, 28, and 29, drawn to the polynucleotide of SEQ ID NO: 40, classified in class 435, subclasses 69.1, 320.1, and 325, and class 536, subclass 23.5.
- XLIX. Claims 30 and 32-36, drawn to a method of treatment, classified in class 514, subclass 2.
- L. Claim 31, drawn to a method of diagnosis, classified in class 435, subclass 7.1.
- LI. Claims 38 and 39, drawn to methods of screening, classified in class 435, subclass 7.1.
- LII. Claim 40, drawn to a PTH agonist, classified in class 530, subclass 350.



Claims appear in more than one group because they encompass more than one invention.

The polypeptides are distinct, each from the other, because they have different sequences and thus different structural and functional characteristics.

The polypeptides are not related to the polynucleotides because they differ structurally and functionally, can not be used together or interchangeably, and have non-coextensive searches and considerations.

The polypeptides are distinct from the methods of treatment because they have other uses, such as diagnosis and screening.

The polypeptides are distinct from the methods of diagnosis because they have other uses, such as treatment.

The polypeptides are distinct from the methods of screening because they have other uses, such as diagnosis and treatment.

The polynucleotides are distinct, each from the other, because they have different sequences and thus different structural and functional characteristics, and encode different proteins with different properties.

The polynucleotides are not related to the methods of treatment, screening, or diagnosis. They can not be used in any of these methods.

The methods of treatment, screening, and diagnosis are distinct from each other because they have different method steps, require different reagents, and have different goals and outcome measures.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above different searches are required for the different groups, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 305-3014 or (703) 308-4242.


Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov](mailto:yvonne.eyler@uspto.gov).

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Art Unit: 1646

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.  
September 26, 2001

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600